

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37  
U.S. Application Serial No. 09/885,151  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RE PATENT Andrew ROUSE, *et al.*  
APPLICATION OF:  
SERIAL No.: 09/885,151  
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DOCKET No.:  
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No.:  
ART UNIT: 2645  
EXAMINER MD S. ELAHEE  
FOR: SYSTEM AND METHOD FOR PROVIDING ACCESS TO FORMS FOR  
DISPLAYING INFORMATION ON A WIRELESS ACCESS DEVICE

**APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37**

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Dear Sir:

Further to the Notice of Appeal filed on **January 18, 2006**, Appellants respectfully submit a complete new Appeal Brief pursuant to 37 C.F.R. §41.37.

The Director is authorized to charge the \$500.00 fee for filing an Appeal Brief pursuant to 37 C.F.R. § 41.20(b)(2). The Director is further authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No.

033975 (Ref. No. 042846-0312951).

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**REQUIREMENTS OF 37 C.F.R. §41.37**

**I. 37 C.F.R. § 41.37(C)(1)(I) – REAL PARTY IN INTEREST**

The real party in interest is International Business Machines Corporation.

**II. 37 C.F.R. § 41.37(C)(1)(II) RELATED APPEALS AND INTERFERENCES**

Appellants are aware of no related appeals or interferences.

**III. 37 C.F.R. § 41.37(C)(1)(III) STATUS OF CLAIMS**

Pending: Claims 1-34, 36-45 and 47-62 are pending.

Cancelled: Claims 35 and 46 are cancelled.

Rejected: Claims 1-34, 36-45 and 47-62 stand rejected.

Allowed: No claims have been allowed.

On Appeal: The rejections of claims 1-34, 36-45 and 47-62 under  
35 U.S.C. § 103(a) are appealed.

**IV. 37 C.F.R. § 41.37(C)(1)(IV) STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the Final Office Action (Paper No. 101405) mailed October 20, 2005 (hereinafter the “Final Action”).

**V. 37 C.F.R. § 41.37(C)(1)(V) SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention provides a system and method for enabling users to access forms for displaying information on a wireless device (130), such as a mobile phone,

interactive pager, PDA or other wireless device, via a wireless service provider. The forms of the present invention may facilitate a user's ability to retrieve, view and send various types of information from a wireless client device (130). Different types of forms may include facsimile, memorandum, invitation, user profile and other applications. *See* Specification, *e.g.*, pg. 3, line 23- pg. 4, line 12. Forms for each application may include predetermined form fields that are specific to each application. *See* paragraph 12. Forms may be created, modified and forwarded (or sent) to one or more selected recipients. *See* Specification, *e.g.*, pg. 7, lines 6-15 and Abstract. Other operations may also be performed.

One aspect of the invention relates to a system and method for formatting a document that includes transmissible media content based on input generated at a wireless client device (130), the document including fields for displaying the transmissible media content. According to an embodiment of the invention, a user may select one or more fields (*e.g.*, rich text, text, date/time, number, checkbox radio button, listbox, authors, names, readers, and other fields) for displaying the transmissible media content (*e.g.*, e-mail, fax, memo, calendar events, etc.). For example, a forms module (414) on a mobile device access system (400) may enable the selection of fields. A mobile device may include display screen for displaying the transmissible media content. *See* Specification *e.g.*, pg. 16, lines 8-15; pg. 17, line 11- pg. 18, line 3; pg. 23, line 17- pg. 24, line 4; pg. 24, line 13- pg. 26, line 6; pg. 18, line 19- pg. 19, line 9; and fig. 8.

According to an embodiment of the invention, a plurality of different forms (*e.g.*, facsimile, memorandum, invitation, user profile, etc.) may comprise a full form that includes all of the fields available for displaying the transmissible media content. For example, a full memo view may include a form field, data field, send to field, copy to field, subject field, body field and other fields. *See* Specification, *e.g.*, pg. 26, line 7-pg. 27,

line 8.

According to an embodiment of the invention a plurality of different forms presented (e.g., facsimile, memorandum, invitation, user profile, etc.) may comprise a brief form that includes the user selected one or more fields for displaying portions of the transmissible media content that correspond to the user selected fields wherein the user selected fields are less than all the available fields. For example, a brief memo view may display a selected portion of a memo, such as the body of the text or portion of the body field. *See Specification, e.g., pg. 26, line 7-pg. 27, line 4.*

According to an embodiment of the invention a wireless client device (130) may be enabled to select at least one form from the plurality of different forms for displaying the transmissible media content. For example, user interface 310 may include a form which may be completed by an application designer (or other authorized entity) in order to identify the design elements that may be used in a mobile application. *See Specification, e.g., pg. 15, line 1-7.*

According to an embodiment of the invention a form application may be provided that is associated with the selected form to format the transmissible media content according to the selected form. A processor means (e.g., processing unit, code, forms module 414) may provide the form application. Various applications may include facsimile, memorandum, invitation and other applications. Forms for each application may include predetermined form fields that are specific to each application. *See Specification, e.g., pg. 26, lines 7-12.*

According to an embodiment of the invention formatted transmissible media content may be transmitted via a wireless medium (e.g., Wireless Application Protocol, Bluetooth protocol, Global System Mobile protocol, Wireless Markup Language protocol

and other wireless communications protocols). For example, a communications means (e.g., communications module, communicating code) may be implemented to transmit data to various destinations via a mobile service provider 116, wireless access server 126 or wireless application protocol server 240. Transmission may be to one or more recipients (e.g., mobile device, fax machine) selected from an address book 424, directory or other database 128. *See* Specification, e.g., pg. 11, lines 7-22 and pg. 39 line 19- pg. 40, line 9.

**VI. 37 C.F.R. § 41.37(C)(1)(VI) Grounds of Rejection to be Reviewed on Appeal (35 U.S.C. § 103).**

Claims 1-34, 36-45, 47-60 and 62 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,701,378 to Gilhuly *et al.* (hereinafter “Gilhuly”) in view of U.S. Patent No. 6,199,099 to Gershman *et al.* (hereinafter “Gershman”). *See* Final Office Action, pg. 3.

Claim 61 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gilhuly in view of Gershman and in further view of U.S. Patent No. 6,169,911 to Wagner *et al.* (hereinafter “Wagner”). *See* Final Office Action, pg. 8.

**VII. 37 C.F.R. § 41.37(C)(1)(VI) ARGUMENT**

**A. Claims 1-34, 36-45, 47-60 and 62 are patentable over Gilhuly in view of Gershman.**

The Examiner legally erred in rejecting claims 1-34, 36-45, 47-60 and 62 under 35 U.S.C. §103(a) over Gilhuly in view of Gershman. Claims 1-34, 36-45, 47-60 and 62 are patentable for *at least* the reasons that: (1) the Examiner relies on non-analogous art for the rejection of claims 1-34, 36-45, 47-60 and 62; (2) assuming *arguendo* that the art is deemed analogous, there is no legally proper teaching, suggestion, or motivation to modify

Gilhuly to include the teachings of Gershman; and (3) assuming *arguendo* that there was a legally proper teaching, suggestion, or motivation to combine Gilhuly and Gershman, the references, even if combined, fail to disclose, teach, or suggest all of the claim elements.

“The foundational facts for the *prima facie* case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art.” *In re Mayne*, 104 F.3d 1339, 1341, 41 U.S.P.Q. 2d (BNA) 1451, 1453 (Fed. Cir. 1997) (citing *Graham v. John Deere Co.*, 383 U.S. at 17-18, 86 S.Ct. at 693-94, 148 U.S.P.Q. (BNA) 459, 466-67; *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 877, 27 U.S.P.Q. 2d (BNA) 1123, 1128 (Fed. Cir. 1993)). When present, evidence of secondary considerations “must be considered in determining obviousness.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 667, 57 U.S.P.Q. 2d (BNA) 1161, 1169 (Fed. Cir. 2000).

Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. (BNA) 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. (BNA) 494, 496 (C.C.P.A. 1970).

Additionally, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d (BNA) 1596, 1598-99 (Fed. Cir. 1988).

1. **The Examiner Relies on Non-Analogous Art for the rejection of claims 1-34, 36-45, 47-60 and 62.**

The Examiner's reliance on Gilhuly and Gershman for the rejections of claims 1-34, 36-45, 47-60 and 62 is improper as these references are non-analogous art to Appellants' claimed invention.

Just because a potential prior art reference may have something in common with the claimed invention (e.g. wireless access device) does not necessarily mean that the reference qualifies as prior art that can be considered in a non-analogous analysis. To the contrary, only "analogous art" may be considered. The Examiner has not met his burden of showing that Gilhuly and Gershman qualify as analogous art. Absent such a showing, these references cannot be used in a Section 103 defense. *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 864, 26 USPQ2d (BNA) 1767, 1772-73 (Fed. Cir. 1992).

The identification of analogous art is a factual inquiry that requires determining (1) "whether the art is from the same field of endeavor" as the invention, and if not, (2) "whether it is still reasonably pertinent to the particular problem to be solved." *Wang Labs.*, 993 F.2d at 864 (citation omitted). This two-step analysis frequently demonstrates that references that might appear relevant to a claimed invention are not analogous and therefore may not properly be considered.

Many examples demonstrate this. The Federal Circuit confirmed that the art of petroleum extraction is not analogous to the art of petroleum storage despite both being in the petroleum industry. *In re Clay*, 966 F.2d 656, 659-60, 23 USPQ2d (BNA) 1058, 1060-61 (Fed. Cir. 1992). Fasteners for garments are not analogous to fasteners for a hose clamp. *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Paper stapling is not analogous to surgical stapling. *U.S. Surgical Corp. v. Hospital*

*Prods. Int'l Pty., Ltd.*, 701 F. Supp. 314, 334 (D. Conn. 1988). Single in-line memory modules (SIMMs) for an industrial controller is not analogous to SIMMs for personal computers. *Wang Labs.*, 993 F.2d at 864. Railway car brakes are not analogous to automotive vehicle brakes. *SAB Industri AB v. The Bendix Corp.*, 199 USPQ 95, (E.D. Va. 1978). These cases are important here because Gilhuly and Gershman are not analogous to the claimed invention.

a. *The references are outside Appellants' field of endeavor.*

Gilhuly and Gershman are outside of the inventor's endeavor for at least the reasons that neither of these references relate to the relevant field of endeavor. The inventor's field of endeavor for claims 1-34, 36-45, 47-60 and 62 relate to a system and method for providing access to forms for displaying information on a wireless access device. See Specification, e.g., pg. 1, lines 11-13 and pg. 3, line 23- pg. 4, line 6.

Gilhuly states that the field of the invention relates to a system and method that provides an event-driven redirection computer program ("redirector program") operating at the host system, which, upon sensing a particular user-defined event has occurred, redirects user-selected data items (or parts thereof) from the host system to the user's mobile data communication device. See Gilhuly, e.g., col. 1, lines 14-20.

Gershman is directed to a mobile computing environment that accesses the Internet to obtain product information for a user utilizing distributed communication network. See Gershman e.g., col. 1, lines 9-11.

These fields of endeavor are not within the inventor's field of endeavor. Neither are directed to providing access to forms for displaying information on a wireless access device.



b. *The references are not reasonably pertinent to the particular problem(s) with which Appellants were involved.*

Since Gilhuly and Gershman are outside the inventor's field of endeavor, the inquiry becomes whether these references are reasonably pertinent to the particular problem(s) with which Appellants were involved. They are not. These problems include: (1) providing information to a mobile device which can be easily viewable on limited screen space of a mobile device; see Specification, e.g., pg. 2 lines 1-2; (2) providing a mobile device access to critical information stored on a network in a form which is compatible to the mobile user; see Specification, e.g., pg. 2 lines 9-11; (3) providing different classes of mobile devices and wireless networks, having varying capabilities and limitations, access to corporate and other networks; see Specification, e.g., pg. 2 lines 14-17; and (4) providing the ability on a mobile device to perform customizations to allow viewing, storing, sending, and maneuvering of information on mobile devices; See Specification, e.g., pg. 3 lines 18-20.

Gilhuly is concerned with the problem of providing real-time synchronization between host and mobile device including providing an automated, continuous, efficient, flexible and reliable system of ensuring the user data items are replicated (in real-time) at the user's mobile device. See Gilhuly, e.g., col. 1, lines 53- col. 2 lines 8. Gilhuly does not relate to the problems with which Appellants were involved such as providing information to a mobile device which can be easily viewable on limited screen space of a mobile device. In fact, Gilhuly, particularly points out that data items (e.g., fax, voice mail) that are not compatible with mobile devices are redirected away from the mobile device. See Gilhuly, e.g., col. 5, lines 1-8; col. 6, lines 53-57; col. 16, lines 31-34. The Examiner cites no evidence that a person having ordinary skill in the art would reasonably have expected

to solve the problems of providing access to information (e.g., forms) for displaying, viewing, storing, sending and maneuvering critical information on a mobile device by considering the problem(s) of redirecting data items.

Gershman is concerned with the problem of providing packaged services and effectively acquiring user-specific knowledge from the user and utilizing it to perform targeted acquisition of information on behalf of the user. *See Gershman, e.g., col. 2 lines 10-13, lines 21-24 and lines 51-53.* A person having ordinary skill in the art would not reasonably have expected to consider Gershman because the subject matter with which Gershman deals, logically would not commend itself to an inventor's attention in considering the present problem solved. For example, to solve the problem of providing mobile devices with customization to view, store, send and maneuver information, one of ordinary skill in the art would not logically have considered the problem of providing packaged services to perform targeted acquisition of information on behalf of the user.

For at least the foregoing reasons, Gilhuly and Gershman are non-analogous to the inventions of claims 1-34, 36-45, 47-60 and 62. The rejection based thereon should therefore be reversed.

**2. There is no legally proper teaching, suggestion, or motivation to modify Gilhuly to include the teachings of Gershman.**

Assuming *arguendo* that Gilhuly and Gershman qualify as analogous art, there is no legally proper teaching, suggestion, or motivation to modify Gilhuly to include the teachings of Gershman.

The Examiner admits that Gilhuly does not teach "enabling a user to select one or more fields for displaying the transmissible media contents" and "a brief form that includes the user selected one or more fields for displaying portions of the transmissible

media content that correspond to the user selected fields wherein the user selected fields are less than all the available fields.” See Final Action at pg. 4. The Examiner’s rejection, however, incorrectly relies on Gershman to teach the missing elements by alleging that:

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gilhuly to incorporate enabling a user to select one or more of the fields for displaying the transmissible media content as taught by Gershman. The motivation for the modification is to have doing so in order to assist a particular user to view a particular information in accordance with his interest. **See Final Action pg. 4, paragraph 1.**

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gilhuly to incorporate a brief form that includes the user selected one or more fields for displaying portions of the transmissible media content that corresponds to the user selected fields, wherein the user selected fields are less than all the available fields as taught by Gershman. The motivation for the modification is to have doing so in order to provide access to a particular activity in accordance with user’s interest. **See Final Action pg. 4, paragraph 2.**

To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. The Examiner’s rejection fails to provide any such motivation. Rather, the general recitation of allowing users to view and access information in accordance with a user’s interest does not show why it would have been obvious to modify the particular system and method of Gilhuly to include enabling a user to select one or more fields for display and a brief form that includes the user selected one or more fields for display.

3. **Gilhuly and Gershman, even when combined, fail to disclose, teach, or suggest all of the elements of claims 1-34, 36-45, 47-60 and 62.**

Assuming *arguendo* that Gilhuly and Gershman could be combined, the combined references fail to disclose, teach, or suggest all of the elements of claims 1-34, 36-45, 47-60 and 62.

a. **Independent claims 1, 9, 17, 25 and 53.**

Independent claim 1 recites, among other things, the claim elements of “**enabling selection, on the wireless client device, of at least one form from the plurality of different forms for displaying the transmissible media content, providing a form application associated with the selected form to format the transmissible media content according to the selected form; and transmitting the formatted transmissible media content via a wireless medium.**” Claims 9, 17, 25 and 53 recite similar features.

The Examiner’s rejection (see Final Action at pg. 3) cites the following passages, shown below, from Gilhuly to teach these features.

Once an event has triggered redirection of the user data items, the host system then repackages these items in a manner that is transparent to the mobile data communication device, so that information on the mobile device appears similar to information on the user’s host system. The redirector program also provides a set of software-implemented control functions for determining the type of mobile data communication device and its address, for programming a preferred list of message types that are to be redirected, and for determining whether the mobile device can receive and process certain types of message attachments, such as word processor or voice attachments. The mobile device control functions are initially set by the user of the mobile device at the host system. These functions can then be altered on a global or per message basis by transmitting a command message from the mobile device to the host system. **Gilhuly at col. 2, lines 34-51**

A user of the present invention can configure the redirector program 12 to push certain user-selected data items to the user’s mobile data communication device 24 when the redirector 12 detects that a particular user-defined event trigger (or trigger point) has taken place. User-selected data items preferably include E-mail messages, calendar events, meeting notifications, address entries, journal entries, personal alerts, alarms, warnings, stock quotes, news bulletins, etc. Alternatively, the user-selected data items could include any other type of message that is transmitted to the

host system 10A, or that the host system 10A acquires through the use of intelligent agents, such as data that is received after the host system 10A initiates a search of a database, a Web site or a bulletin board. Gilhuly at col. 5, lines 44-53

None of these cited passages, however, disclose “enabling selection...of at least one form...for *displaying* the transmissible media content;” “providing a *form application associated with the selected form to format* the transmissible media content according to the selected form;” and “*transmitting the formatted...content.*” *Emphasis added.* Rather, Gilhuly appears to describe selecting data items that are to be redirected. Gilhuly does not teach forms for displaying content, much less providing a form application to format the content. Gilhuly states:

The present invention includes the ability to redirect certain message attachments to such an external machine 30 if the redirector program configuration data reflects that the mobile device 24 cannot receive and process the attachments, or if the user has specified that certain attachments are not to be forwarded to mobile device 24, even if such device can process those attachments. See Gilhuly, col. 5, lines 1-8

If the user's type of mobile device cannot accept a particular type of attachments, then the redirector 12 can be programmed to route those attachments to a fax or voice number where the user is located using an attached fax or voice machine 30. See Gilhuly, col. 6, lines 53-57

If the user's type of mobile device 220 cannot accept certain types of attachments, then the redirector program 242 can be programmed to route the attachments to a fax or voice number where the user is located. See Gilhuly, col. 16, lines 31-34.

Gilhuly does not even attempt to format content for display. Instead it redirects content to destinations that are able to display the content without having to do any formatting to the content. For example, faxes get sent to fax machines and voice message get sent to a voice machine.

Gershman fails to cure all the deficiencies of Gilhuly, as set forth above. Gershman is directed to a system and method for collecting data from distributed network sources based on a user query and creating customized information according to user's content and layout preferences. *See* Gershman, e.g., Fig. 10B, col. 2 lines 55-67; col. 28 line 64- col. 29 line15; and col. 31 lines 29-55. Specifying content and layout preferences, however, are not the same as "enabling selection...of at least one *form from the plurality of different forms* for displaying the transmissible media content.

Additionally, the Examiner concedes that Gilhuly does not disclose "enabling a user to select one or more fields for displaying the transmissible media contents" and "a brief form that includes the user selected one or more fields for displaying portions of the transmissible media content that correspond to the user selected fields wherein the user selected fields are less than all the available fields." The Examiner's rejection (see Final Action at pg. 4) cites the following passages, shown below, from Gershman to show the missing elements.

FIG. 21 illustrates a managing daily logistics display in accordance with a preferred embodiment. A user is greeted by an animated agent 2100 with a personalized message 2190. The user can select from various activities based on requirements, including travel 2110, household chores 2120, finances 2130 and marketplace activities 2140. Icons 2142 for routine tasks such as e-mail, calendaring and document preparation are also provided to facilitate rapid navigation from one activity to another. Direct links 2146 are also provided to allow transfer of news and other items of interest. Various profiles can be selected based on where the user is located. For example, work, home or vacation. The profiles can be added 2170 as a user requires a new profile for another location. Various items 2180 of personal information are collected from the user to support various endeavors. Moreover, permissions 2150 are set for items 2180 to assure information is timely and current.

FIG. 22 illustrates a user main display in accordance with a preferred embodiment. World 2200 and local news 2210 is provided based on a user's preference. The user has also selected real estate 2230 as an item to provide direct information on the main display. Also, a different agent 2220 is

provided based on the user's preference. **See Gershman at col. 36 lines 41-64.**

The Examiner further alleges that figure 21 of Gershman shows a full form. Fig. 21 merely describes managing daily logistics wherein the user selects a profile based on where the user is located. This is not the same as "a full form that includes all the fields available for displaying the transmissible media content."

Furthermore, Gershman discloses collecting content according to user's various preferences (e.g., location). This, however, is not the same as "displaying *portions* of the transmissible media content that correspond to the user selected fields." Rather, Gershman collects content according to user preferences and requirements and displays all, not portions, of the content to the user. For example Gershman discloses:

mySite! is a high-impact, Internet-based application in accordance with a preferred embodiment that is focused on the theme of delivering services and providing a personalized experience for each customer via a personal web site in a buyer-centric world. The services are intuitively organized around satisfying customer intentions--fundamental life needs or objectives that require extensive planning decisions, and coordination across several dimensions, such as financial planning, healthcare, personal and professional development, family life, and other concerns. **See Gershman, col. 29 lines 56-65**

An Egocentric Interface is a user interface crafted to satisfy a particular user's needs, preferences and current context. It utilizes the user's personal information that is stored in a central profile database to customize the interface. The user can set security permissions on and preferences for interface elements and content. The content integrated into the Egocentric Interface is customized with related information about the user. When displaying content, the Egocentric Interface will include the relationship between that content and the user in a way that demonstrates how the content relates to the user. **See Gershman, col. 30 lines 30-40**

The user accesses a Web Browser 1810 and requests product and pricing information from the integrator. The request is sent from the user's browser to the integrator's Web/Application Server 1820. The user's preferences and personal information is obtained from an integrator's customer profile database 1830 and returned to the Web/Application server. The requested product information is extracted from the supplier's product database 1840

and customized for the particular customer. The Web/Application server updates the supplier's customer information database 1850 with the inquiry information about the customer. See Gershman, col. 35 lines 46-56

This word extends the word "eCommerce" to mean "personalized electronic commerce." FIG. 20 illustrates a display login in accordance with a preferred embodiment. The display is implemented as a Microsoft Internet Explorer application with an agent 2000 that guides a user through the process of interacting with the system to customize and personalize various system components to gather information and interact with the user's personal requirements. See Gershman, col. 36 lines 29-36.

As such, there is no brief form for displaying *portions* of content that correspond to user selected fields because all content that corresponds to a user preferences and requirements are displayed.

Therefore, Gilhuly and Gershman, even when combined fail to teach or suggest all of the claim elements. Accordingly, the rejection of at least claims 1, 9, 17, 25, and 53 should be reversed. Appellants further submit that dependent claims 3, 11, 19, 27, 4, 12, 20, 28, 6, 14, 22, 30, 7, 15, 23, 31, 38, 48, 55, 39, 54, 56, 57 and 59, are allowable because they depend from one of allowable independent claims 1, 9, 17, 25, and 53, as well as for the other limitation they contain.

b. Dependent claims 2, 5, 8, 10, 13, 16, 18, 21, 24, 26, 29, 32-34, 36, 37, 40-45, 47, 50-52, 58, 60 and 62

Appellants submit that dependent claims 2, 5, 8, 10, 13, 16, 18, 21, 24, 26, 29, 32-34, 36, 37, 40-45, 47, 50-52, 58, 60 and 62 are allowable because they depend from one of allowable independent claims 1, 9, 17, 25, and 53, as well as for the further limitations they contain, described below.

Claims 2, 10, 18, 26, 42 and 52

Claims 2, 10, 18, 26 and 42 recite, "selection of at least one of the brief form, the full form, a create form, a modify form, a delete form, a forward form, a fax form, and a



send form.” Claim 52 recites, “input interface enables a user to select one of an entire form and a brief form, wherein the brief form presents a portion of the at least one form.” The passage relied on in Gilhuly (col. 12 lines 12-25) does not appear to disclose the element(s) of claim 2, 10, 18, 26, and 52. For at least this reason, the rejection of claims 2, 10, 18, 26, and 52 is improper and should be reversed.

Claims 5, 13, 21 and 29

Claims 5, 13, 21 and 29 recite, “one presentation option comprises at least one of a facsimile form, a memorandum form, an invitation form, and a user profile form.” The passages relied on in Gilhuly (col. 5, lines 44-53 and col. 12 lines 12-25) do not appear to disclose the elements of claims 5, 13, 21, and 29. For at least this reason, the rejection of claims 5, 13, 21, and 29 is improper and should be reversed.

Claims 8, 16, 24 and 32

Claims 8, 16, 24 and 32 recite “the form application comprises at least one form and at least one related subform.” The passage relied on in Gilhuly (col. 5, lines 44-63) does not appear to disclose the elements of claims 8, 16, 24 and 32. For at least this reason, the rejection of claims 8, 16, 24 and 32 is improper and should be reversed.

Claims 33, 34, 36, 37, 43, 44, 45 and 47

Claims 33 and 43 recite, “the selected at least one form comprises at least two predetermined fields.” Claims 34 and 44 recite, “one or more of the at least two predetermined fields is automatically pre-filled.” Claim 36 recites, “each of the plurality of different forms is associated with at least one communication type.” Claims 37 and 47 recite, “selection of at least one form, on the wireless client device, comprises enabling selection of a communication type from a plurality of different communication types.” Claim 45 recites, “at least one form is selected by a user.”

The Examiner relies on the same passage from Gilhuly (col. 5 lines 44-53) to reject all the elements of claim 33, 34, 36, 37, 43, 44, 45 and 47. This passage, however, does not appear to disclose the elements of claims 33, 34, 36, 37, 43, 44, 45 and 47. For at least this reason, the rejection of claims 33, 34, 36, 37, 43, 44, 45 and 47 should be reversed.

Claims 40, 41, 50, 51, and 58

Claims 40 and 50 recite, “the selected at least one form is a custom made form.” Claims 41 and 51 recite, “creating a custom action associated with the selected at least one form option.” Claim 58 recites, “the at least one forms module enables creation of custom forms.” The Examiner relies on the same passages from Gilhuly (col. 5 lines 44-53 and col. 12 lines 12-25) to reject all the elements of claims 40, 41, 50, 51, and 58. This passage, however, does not appear to disclose the elements of claims 40, 41, 50, 51, and 58. For at least this reason, the rejection of claims 40, 41, 50, 51, and 58 should be reversed.

Claims 60 and 62

Claim 60 recites, “the form selected by the user includes at least two predetermined fields, wherein a first predetermined field includes content and a second predetermined field includes an action property, and wherein the action property facilitates communication of the content of the first predetermined field to the one or more receiving terminals.” Claim 62 recites, “the action property is pre-stored in the second predetermined field.” The passage relied on in Gilhuly (col. 5, lines 19-63) does not appear to disclose the elements of claims 60 and 62. For at least this reason, the rejection of claims 60 and 62 is improper and should be reversed.

**B. Claim 61 is patentable over Gilhuly, Gershman and Wagner (103)**

Regarding claim 61, the Examiner asserts that “Gilhuly in view of Gershman does not specifically teach the action property includes one or a Mail TO property and a Dial Phone property,” (see Final Action at pg. 8) and relies on Wagner to overcome this deficiency. However, even if Wagner did teach this feature, and Appellants assert that it does not, Wagner does not remedy the deficiencies of Gilhuly and Gershman set forth above. Specifically, Wagner does not disclose a brief form including only user selected fields. Thus, claim 61 is patentable over Gilhuly, Gershman, and Wagner for at least this reason.

**VIII. 37 C.F.R. §41.37(c)(1)(viii) - CLAIMS APPENDIX**

**Appendix A:** The pending claims (claims 1-34, 36-45 and 47-62) are attached in **Appendix A.**

**IX. 37 C.F.R. §41.37(c)(1)(ix) - EVIDENCE APPENDIX**

**Appendix B: (None)**

**X. 37 C.F.R. §41.37(c)(1)(x) - RELATED PROCEEDINGS INDEX**

**Appendix C: (None)**

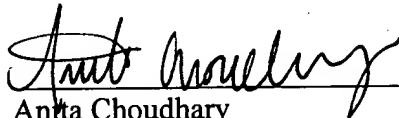
**CONCLUSION**

For at least the foregoing reasons, Appellant respectfully requests that the rejection of each of the pending claims be reversed.

Date: March 20, 2006

Respectfully submitted,

By:



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## APPENDIX A

1. **(Previously Presented):** A method of formatting a document that includes transmissible media content based on input generated at a wireless client device, the document including fields for displaying the transmissible media content, the method comprising:
  - enabling a user to select one or more of the fields for displaying the transmissible media content;
  - presenting a plurality of different forms comprising:
    - a full form that includes all of the fields available for displaying the transmissible media content, and
    - a brief form that includes the user selected one or more fields for displaying portions of the transmissible media content that correspond to the user selected fields wherein the user selected fields are less than all the available fields;
  - enabling selection, on the wireless client device, of at least one form from the plurality of different forms for displaying the transmissible media content;
  - providing a form application associated with the selected form to format the transmissible media content according to the selected form; and
  - transmitting the formatted transmissible media content via a wireless medium.
2. **(Previously Presented):** The method of claim 1, wherein enabling selection of at least one form further comprises :
  - enabling selection of at least one of the brief form, the full form, a create form, a modify form, a delete form, a forward form, a fax form, and a send form.
3. **(Previously Presented):** The method of claim 1, further comprising:
  - communicating via at least one of a Bluetooth protocol, a Wireless Application protocol, a Global System Mobile protocol, and a Wireless Markup Language protocol.
4. **(Previously Presented):** The method of claim 1, further comprising:
  - presenting the transmissible media content to a user according to at least one presentation option.

5. **(Previously Presented):** The method of claim 4, wherein the at least one presentation option comprises at least one of a facsimile form, a memorandum form, an invitation form, and a user profile form.
6. **(Previously Presented):** The method of claim 1, wherein the transmissible media content comprises at least one of user data, address data, memo data, and search data.
7. **(Previously Presented):** The method of claim 1, further comprising:  
communicating the transmissible media content from a data source remote from the wireless client device.
8. **(Original):** The method of claim 1, wherein the form application comprises at least one form and at least one related subform.
9. **(Previously Presented):** A system for formatting a document that includes transmissible media content based on input generated at a wireless client device, the document including fields for displaying the transmissible media content, the system comprising:  
a forms module enabling a user to select one or more of the fields for displaying the transmissible media content; and  
a display that displays a plurality of forms comprising:  
a full form that includes all of the fields available for displaying the transmissible media content, and  
a brief form that includes the user selected one or more fields for displaying portions of the transmissible media content that correspond to the user selected fields wherein the user selected fields are less than all the available fields;  
an input interface on the wireless client device that enables selection of at least one form from the plurality of forms for displaying the transmissible media content on the wireless client device; and  
a processor unit that provides a form application associated with the selected form to format the transmissible media content according to the selected form and transmits the formatted transmissible media content via a wireless medium.

10. **(Previously Presented):** The system of claim 9, wherein the processor unit is configured to select at least one of the brief form, the full form, a create form, a modify form, a delete form, a forward form, a fax form and a send form.
11. **(Previously Presented):** The system of claim 9, wherein the processor unit is configured to transmit the formatted transmissible media content via at least one of a Bluetooth protocol, a Wireless Application protocol, a Global System Mobile protocol, and a Wireless Markup Language protocol.
12. **(Previously Presented):** The system of claim 9, wherein the processor unit is configured to present the transmissible media content via the display of the wireless client device to a user according to at least one presentation option.
13. **(Previously Presented):** The system of claim 12 wherein the presentation option comprises at least one of facsimile form, memorandum form, invitation form, and user profile form.
14. **(Original):** The system of claim 9, wherein the transmissible media content comprises at least one of user data, address data, memo data, and search data.
15. **(Original):** The system of claim 9, wherein the transmissible media content is transmitted from a data source remote from the wireless client device.
16. **(Original):** The system of claim 9, wherein the form application comprises at least one form and at least one related subform.
17. **(Previously Presented):** A system for formatting a document that includes transmissible media content based on input generated at a wireless client device, the document including fields for displaying the transmissible media content, the system comprising:

selection means enabling a user to select one or more of the fields for displaying the transmissible media content;

display means for displaying a plurality of forms comprising:

a full form that includes all of the fields available for displaying the transmissible media content, and

a brief form that includes the user selected one or more fields for displaying portions of the transmissible media content that correspond to the user selected fields wherein the user selected fields are less than all the available fields;

input interface means for enabling selection of at least one form from the plurality of forms for displaying the transmissible media content on the wireless client device; and

processor means for providing a form application associated with the selected form for formatting the transmissible media content according to the selected form and transmitting the formatted transmissible media content via a wireless medium.

18. **(Previously Presented):** The system of claim 17, wherein the processor means enables selection of at least one of the brief form, the full form, a create form, a modify form, a delete form, a forward form, a fax form and a send form.

19. **(Previously Presented):** The system of claim 17, wherein the processor means transmits the formatted transmissible media content via at least one of a Bluetooth protocol, a Wireless Application protocol, a Global System Mobile protocol, and a Wireless Markup Language protocol.

20. **(Previously Presented):** The system of claim 17, wherein the processor means is configured to present the transmissible media content via the display means to the user according to at least one presentation option.

21. **(Previously Presented):** The system of claim 20 wherein the at least one presentation option comprises at least one of a facsimile form, a memorandum form, an invitation form, and a user profile form.



22. **(Original):** The system of claim 17, wherein the transmissible media content comprises at least one of user data, address data, memo data, and search data.
23. **(Original):** The system of claim 17, wherein the transmissible media content is transmitted from a data source remote from the wireless client device.
24. **(Original):** The system of claim 17, wherein the form application comprises at least one form and at least one related subform.
25. **(Previously Presented):** A storage medium for storing machine readable code, the machine readable code being executable to format a document that includes transmissible media content based on input generated at a wireless client device, the document including fields for displaying the transmissible media content, the storage medium comprising:
- forms selection code that enables a user to select one or more of the fields for displaying the transmissible media content;
  - presenting code that presents a plurality of forms comprising:
    - a full form that includes all of the available fields for displaying the transmissible media content, and
    - a brief form that includes the user selected one or more fields for displaying portions of the transmissible media content that correspond to the user selected fields wherein the user selected fields are less than all the available fields;
  - selecting code that enables selection, on the wireless client device, of at least one form from the plurality of forms for displaying the transmissible media content on the wireless client device;
  - providing code that provides a form application associated with the selected form to format the transmissible media according to the selected form; and
  - communicating code that transmits the formatted transmissible media content via a wireless medium.
26. **(Previously Presented):** The storage medium of claim 25, wherein the selecting code further comprises option selecting code that selects at least one of the brief form, the full

form, a create form, a modify form, a delete form, a forward form, a fax form and a send form.

27. **(Original):** The storage medium of claim 25, further comprising protocol communicating code that communicates via at least one of a Bluetooth protocol, a Wireless Application protocol, a Global System Mobile protocol, and a Wireless Markup Language protocol.

28. **(Original):** The storage medium of claim 25, further comprising presenting code that presents the transmissible media content to a user according to at least one presentation option.

29. **(Previously Presented):** The storage medium of claim 28 wherein the at least one presentation option comprises at least one of a facsimile form, a memorandum form, an invitation form, and a user profile form.

30. **(Original):** The storage medium of claim 25, wherein the transmissible media content comprises at least one of user data, address data, memo data, and search data.

31. **(Original):** The storage medium of claim 25, further comprising remote communicating code that communicates the transmissible media content from a data source remote from the wireless client device.

32. **(Original):** The storage medium of claim 25, wherein the form application comprises at least one form and at least one related subform.

33. **(Previously Presented):** The method of claim 1, wherein the selected at least one form comprises at least two predetermined fields.

34. **(Previously Presented):** The method of claim 33, wherein one or more of the at least two predetermined fields is automatically pre-filled.

35. **(Cancelled).**

36. **(Previously Presented):** The method of claim 1, wherein each of the plurality of different forms is associated with at least one communication type.

37. **(Previously Presented):** The method of claim 1, wherein the step of enabling selection of at least one form, on the wireless client device, comprises enabling selection of a communication type from a plurality of different communication types.

38. **(Previously Presented)** The method of claim 1 wherein enabling selection of at least one form, on the wireless client device, comprises enabling selection of a type of receiving terminal from a plurality of different types of receiving terminals.

39. **(Previously Presented):** The method of claim 38, wherein the plurality of different types of receiving terminals comprise at least one of a facsimile, a computer terminal, and a wireless device terminal.

40. **(Previously Presented):** The method of claim 1, wherein the selected at least one form is a custom made form.

41. **(Previously Presented):** The method of claim 1, wherein the step of formatting further comprises:

creating a custom action associated with the selected at least one form option.

42. **(Previously Presented):** The method of claim 1, wherein the step of enabling selection of at least one form further comprises:

enabling selection, for view by a user, of one of an entire form and a brief option, wherein the brief option only presents a portion of the selected at least one form.

43. **(Previously Presented):** The system of claim 9, wherein the at least one form comprises at least two predetermined fields.

44. **(Previously Presented):** The system of claim 43, wherein one or more of the at least two predetermined fields is pre-filled.

45. **(Previously Presented):** The system of claim 9, wherein the at least one form is selected by a user.

46. **(Cancelled).**

47. **(Previously Presented):** The system of claim 9, wherein the at least one form is selected by selecting a communication type from a plurality of different communication types.

48. **(Previously Presented):** The system of claim 9, wherein the at least one form is selected by selecting a type of receiving terminal from a plurality of different types of receiving terminals.

49. **(Previously Presented):** The system of claim 48, wherein the type of receiving terminal is one of a facsimile, a computer terminal, and a wireless device terminal.

50. **(Previously Presented):** The system of claim 9, wherein the at least one form comprises a custom made form.

51. **(Previously Presented):** The system of claim 9, wherein the input interface enables a user to create a custom action associated with the at least one form.

52. **(Previously Presented):** The system of claim 9, wherein the input interface enables a user to select one of an entire form and a brief form, wherein the brief form presents a portion of the at least one form.

53. **(Previously Presented):** A system for formatting a document that includes transmissible media content based on input generated at a wireless client device, the document including fields for displaying the transmissible media content, the system comprising:

a module that enables a user to select one or more of the fields for displaying the transmissible media content;

a display module that displays a plurality of forms comprising:

a full form that includes all of the fields available for displaying the transmissible media content, and

a brief form that includes the user selected one or more fields for displaying portions of the transmissible media content that correspond to the user selected fields;

at least one forms module that enables selection, on the wireless client device, of a form from the plurality of forms for displaying transmissible media content, and provides a form application associated with the selected form that formats the transmissible media content according to the selected form, such that the user is enabled to edit the document; and

at least one communication module that communicates the document from the client wireless device to one or more receiving terminals.

54. **(Previously Presented):** The system of claim 53, wherein the one or more receiving terminals includes at least one of a facsimile, a computer terminal, and a wireless device terminal.

55. **(Previously Presented):** The system of claim 53, wherein the one or more receiving terminals are other than wireless device terminals.

56. **(Previously Presented):** The system of claim 53, wherein the at least one forms module includes pre-stored forms.

57. **(Previously Presented):** The system of claim 53, wherein the at least one forms module includes pre-stored forms and enables creation of custom forms.

58. **(Previously Presented):** The system of claim 53, wherein the at least one forms module enables creation of custom forms.

59. **(Previously Presented):** The system of claim 53, wherein the at least one forms module enables the user to specify a form type and a plurality of form properties of a custom form.

60. **(Previously Presented):** The system of claim 53, wherein the form selected by the user includes at least two predetermined fields, wherein a first predetermined field includes content and a second predetermined field includes an action property, and wherein the action property facilitates communication of the content of the first predetermined field to the one or more receiving terminals.

61. **(Previously Presented):** The system of claim 60, wherein the action property includes one of a Mail To property and a Dial Phone property.

62. **(Previously Presented):** The system of claim 60, wherein the action property is pre-stored in the second predetermined field.

**APPENDIX B**

NONE

**APPENDIX C**

NONE